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UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

ALTON B. HORNBACK, Plaintiff, v. UNITED STATES OF AMERICA, Defendant.	Civil Case No. 08 CV 0127-WQH-BLM DEFENDANT'S MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF DEFENDANT'S MOTION TO DISMISS Date: June 9 , 2008 Time: 11:00 a.m. Crtrm: 4 Judge: Hon. William T. Hayes [No Oral Argument Unless Requested by the Court]

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I

INTRODUCTION

Alton B. Hornback ("Hornback") again petitions this Court to issue a Writ of Mandamus, in accordance with 28 U.S.C. § 1361, ordering the United States ("Government") via the Director of the United States Patent and Trademark Office ("USPTO"), to: 1) issue him a new patent having revised claims; and 2) issue a new corrected patent incorporating those claims and certain changes to his specification. Petition at 1. Hornback alleges that the Government, specifically the USPTO working at the direction of the Department of Defense, intentionally included numerous "strategically placed" errors in his patent, U.S. Patent No.

6,079,666, "rendering it ununderstandable for counterintelligence purposes." Id. at 1-3, 7. He now alleges that with "malice" the "DOD did willfully conspire with the PTO to withhold from [Mr. Hornback], the allowed patent claims." Id. at 6. Hornback's petition for mandamus should be dismissed because: I) Hornback cannot prove that he is entitled to the drastic remedy of mandamus relief, and ii) Hornback has not met his burden of establishing that this Court has jurisdiction over his petition.

First, Hornback cannot prove that he is entitled to mandamus relief because he has not exhausted all avenues of relief available to him at the USPTO. As the USPTO has repeatedly indicated, Hornback may receive the relief he seeks if he files a proper reissue application with the USPTO. Again, Hornback would rather file a lawsuit than pursue available administrative relief.

Specifically, Hornback seeks an order that the USPTO be instructed to change the language of the claims in his patent. However, the USPTO has already done everything it can to correct errors in his patent by treating his informal request as one falling under 35 U.S.C. §§ 254 and 255 ("Certificate of Correction").[1/] But those statutes can only be used to correct mistakes that are clerical in nature. The USPTO simply cannot revise his patented claims until they are substantively reviewed to determine patentability. Rather, as the USPTO has repeatedly told him, Hornback must file a proper request for a "reissue" of his patent in accordance with 35 U.S.C. § 251.

But Hornback has not pursued this option. He has not filed a proper "reissue" request under 35 U.S.C. § 251, even though he asks this Court to issue claims that have never been examined. To date, he has merely submitted brief letters to the USPTO requesting a new patent. His efforts to comply with the requirements for filing a proper reissue application fall far short of what is required. And it is worth noting that these efforts pale in comparison to the efforts he and the Government have expended in litigation during the last several years.

[1/] Hornback did work with the USPTO to correct errors in his specifications, which resulted in the issuance of a Certificate of Correction. But even that positive result is a source of contention for Hornback.

Even viewing facts in a light most favorable to Hornback, his petition fails to state a claim upon which relief should be granted and should be dismissed in accordance with Fed. R. Civ. P. 12(b)(6).

Second, Hornback's petition only properly invokes the Mandamus Statute, 28 U.S.C. § 1361. That statute, however, does not provide a waiver of sovereign immunity. And the Mandamus Statute cannot be invoked to compel the USPTO to issue Hornback a new patent since Congress has vested that discretion to the USPTO Director. Accordingly, Hornback's petition should be dismissed for lack of jurisdiction in accordance with Fed. R. Civ. P. 12(b)(1). For these reasons, this Court should dismiss Hornback's petition.

II

BACKGROUND

A. FACTUAL BACKGROUND

This suit, like the numerous suits Hornback has filed against the Government involving his patent, arises out of the Government's classification of Hornback's patent application as secret, an imposition of a secrecy order on that application, and the eventual issuance of his patent.

On April 25, 1986, Hornback filed a patent application for a "Real Time Boresight Error Slope Sensor." Hornback v. United States, 405 F.3d 999, 1000 (Fed. Cir. 2005). Pursuant to 35 U.S.C. § 181, the United States Patent and Trademark Office ("PTO") entered a secrecy order for Hornback's patent application on August 24, 1987. Id. The secrecy order unequivocally notified Hornback that restrictions applied to his patent application. Id. The PTO issued a Notice of Allowability for Hornback's patent application on September 17, 1987, but continued to withhold it from issue because of the secrecy order. Id. This secrecy order was subsequently renewed each year until a rescinding order was issued on April 21, 1999, after certain classified information had been expunged from the prosecution history. Id. The patent application issued on June 27, 2000, as U.S. Patent No. 6,079,666. Id.

Citing typographical errors in his printed patent, Hornback has repeatedly alleged that the Department of Defense instructed the USPTO to "strategically place[]" errors in his patent to render it "ununderstandable for counterintelligence purposes." Pet. at 1, 7. Hornback further argues that the USPTO must also correct errors in his claims as a result of a "conspiracy between DOD and PTO to print invalid claims." Pet. at 4-7. In essence, he contends that when the USPTO initially issued his patent, it issued the wrong version of claims. Id.

The alleged errors in his claims involve two amendments Hornback filed in May of 1987. Pet. at 4. The two amendments were very similar: I) both contained a request to cancel original claims 1-2; ii) both contained a request to replace those claims with new claims 3-6; iii) and both versions of claims 3-6 included similar language. Specifically, in a filing dated May 1, 1987,[2/] Hornback submitted a first amendment cancelling claims 1-2 and replacing them with a first version of claims 3-6. Ex. A; Pet. at 4. Days later,[3/] Hornback submitted a second amendment also cancelling claims 1-2 and replacing them with claims Hornback again designated as claims 3-6—the language of this second version of claims 3-6 being only slightly different from the language of the first. Ex. B; Pet. at 4. The USPTO marked the second, May 1987 amendment, as a "[d]uplicate" of the first amendment. Following that, the examiner picked up the application for review, examined the claims of the first amendment only, and determined that those claims were patentable. As a result, Hornback's patent issued with the version of claims found in the first of these two amendments.

Since then, Hornback has filed over a dozen suits under the same set of operative facts as presented in this Petition, both in the United States District Court for the Southern District of California ("Southern District of California")[4/] and in the United States Court of Federal

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[2/] The USPTO stamp indicates that this document was received May 4, 1987.

[3/] The document is dated May 6, 1987, and the USPTO stamp indicates that this document was received May 11, 1987.

[4/] Hornback v. United States, Civil Action No. 89-1914-R(M) (S.D. Cal. Oct. 2, 1992), aff'd,16 F.3d 422 (Fed. Cir. 1993) (non-precedential);Hornback v. United States, No. 94CV0952-IEG (S.D. Cal.), aff'd, 91 F.3d 152 (9th Cir. 1996) (unpublished); Hornback v. U.S., 127 Fed. Appx. 964, 965, 2005 WL 844627 (9th Cir. April 13, 2005) (unpublished).

Claims ("Court of Federal Claims")[5], alleging various theories of recovery for the alleged wrongs perpetrated on him by the Government by imposing a secrecy order on his patent application. In many of the lawsuits Hornback filed after his patent issued he has alleged that the USPTO intentionally included errors in his patent. All of Hornback's claims against the Government have been dismissed.[6]

In fact, in Hornback v. United States, 52 Fed. Cl. 374 (Fed. Cl. 2002) (No. 99-38 C), aff'd, No. 02-5111, 2002 WL 31796654 (Fed. Cir. Dec . 4, 2002) (unpublished), Hornback petitioned the Federal Circuit "to order the PTO to issue a new patent," alleging that the errors in the patent were caused by the USPTO and must be corrected. Id. at *2. The Court refused, stating:

> We will not issue such an order because Hornback has failed to exhaust his administrative remedies. See McKart v. United States, 395 U.S. 185, 193, 89 S.Ct. 1657, 23 L.Ed.2d 194 (1969). He has not offered evidence that he has filed for a certificate of correction under 35 U.S.C. § 254 or reissue under 35 U.S.C. § 251.

Id.[7] Two earlier suits were also dismissed for failure to exhaust administrative remedies, see

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[5] Hornback v. United States, No. 96-121 C; Hornback v. United States, 96-647 C; Hornback v. United States, No. 98-58 C; Hornback v. United States, No. 99-38 C; Hornback v. United States, 99-168 C; Hornback v. United States, 00-374 C; Hornback v. United States, 01-99 C; Hornback v. United States, 01-136 C; Hornback v. United States, 02-1915 C; Hornback v. United States, 03-2063 C.

[6] The Federal Circuit has warned Hornback that his continued filing of new cases involving the Government's secrecy order and his claims for money damages have become abusive and stated that: "Hornback is therefore warned that further appeals involving claims based on the same set of facts, whether raising the same or new theories, may be held to be frivolous and subject to sanctions." See Hornback v. United States, Nos. 03-5108, -5111, slip op. at 8-9, 2004 WL 68511, *5 (Fed. Cir. Jan. 13, 2004). Subsequently, the Court of Federal Claims sanctioned Hornback holding:

> Plaintiff has availed himself fully of the judicial process in fervently litigating his claim for damages allegedly resulting from the Government's imposition of a secrecy order on his patent application for a Real-Time Boresight Error Slope Sensor. To prevent abuse of the judicial process by plaintiff, the court bars plaintiff from filing any additional actions in this court arising out of any claims he may have relating to the classification of his patent application or the imposition of a secrecy order on his patent application absent advance written permission by a judge of this court.

Hornback v. United States, 62 Fed. Cl. 1, 6 (2004), aff'd, 405 F.3d 999 (Fed. Cir. 2005).

[7] Ultimately, in a recent precedential decision, the Federal Circuit upheld a ruling by the Court of Federal Claims that the court did not have subject matter jurisdiction of an adverse ruling of the PTO Director, but that jurisdiction over those claims lies in district court. Hornback v. United States, 405

(continued...)

Hornback v. United States, 178 F.3d 1308 (Fed. Cir. 1998) (non-precedential) (Fed. Cl. No. 96-647 C); Hornback v. United States, No. 98-58 C (Fed. Cl. July 8, 1999), and Hornback voluntarily dismissed one suit. Hornback v. United States, No. 01-136 C (Fed. Cl. April 30, 2002).

Most recently, in Hornback v. United States, No. 06-1387 (S.D. Cal. May 15, 2007), this Court dismissed a similar petition for Mandamus. In that case, because Hornback did not allege any specific statutory duty authorizing the Court to grant Mandamus relief, this Court concluded that it lacked jurisdiction over Hornback's petition. The Court further found that the Government had not waived sovereign immunity. Finally, this Court found that by failing to exhaust all possible relief available to him at the USPTO, the Court should not entertain Hornback's request for Mandamus relief.

Following that decision, on May 25, 2007, Hornback submitted a two-page letter to the USPTO, which he styled, "Petition to Reissue Patent No. 6,079,666, Pursuant to 35 U.S.C. § 131, so that it Conforms to Allowed Patent Application No. 06/859,033." Ex. C. In that brief letter, Hornback again requested the USPTO issue a new patent to correct alleged errors in his specification and claims. Id. at 1-2.

Over the course of the next several months, the USPTO and Hornback worked together to identify and correct errors in his specification.[8/] On July 25, 2007, the USPTO sent Hornback a letter documenting its intent to issue a Certificate of Correction. Ex. D. Citing the requirements of 37 C.F.R. § 1.322(b), the USPTO explained that correction via a Certificate of Correction was appropriate in this case because the errors to be corrected were not "so numerous" to necessitate the issuance of an entirely new patent. Id at 2. The USPTO also refused to consider Hornback's request to correct the claims, finding his request insufficient both in form and substance. Instead, it suggested that Hornback consider filing a

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[7/](...continued)
F.3d 999, 1002 (Fed. Cir. 2005).

[8/] The vast majority of errors Hornback complained of consisted of misprinting of mathematical symbols such as "±", or the Greek letters "β" or "τ"; spacing errors, or other such typographical errors.

reissue application, and further recommended that Hornback hire a patent attorney to help him handle these complex matters. Id. at 3-4.

Hornback filed responses dated August 2, 2007 (Ex. E) and August 8, 2007 (Ex. F). In those filings he: 1) reiterated his previous complaints; 2) noted an error in the USPTO's proposed Certificate of Correction; 3) provided a list of alleged errors in the issued claims; and 4) requested that the USPTO reissue his patent in accordance with 35 U.S.C. § 251. By letter dated Nov. 6, 2007, the USPTO notified Hornback that it would issue a Certificate of Correction to correct errors in his specification in the manner provided in Hornback's response of August 2, 2007. Ex. G. Regarding Hornback's request to correct his issued claims, the USPTO indicated that his letter could not be treated as a "reissue application" under 35 U.S.C. § 251 because it failed to meet the requirements of the applicable statutes and regulations. Id. at 3. Thus, along with its written response, the USPTO sent Hornback a copy of Chapter 1400 of the MPEP (Ex. H) explaining that Chapter 1400 provides the procedures for filing and processing reissue applications. Id. at 4.

In the interests of justice, the USPTO treated Hornback's request to correct the claims as a request for a Certificate of Correction, and forwarded his request to the appropriate department. Ex. G at 3. After full consideration, the USPTO denied Hornback's request. In a letter dated January 8, 2008, the USPTO found that Hornback's requested changes were substantive because they would broaden the claims and, therefore, "may affect patentability of claims." Ex. I. In a decision dated April 3, 2008 (Ex. J), the USPTO noted that just days apart, Hornback had submitted two sets of similar claims with identical numbering (both sets submitted as claims 3-6), in direct violation of the applicable regulations. Ex. J at 5-6. As a result, the second set of claims 3-6, which Hornback asserts should be the claims in his issued patent, were treated as "duplicate[s]" and never examined. Id. at 6. Because the USPTO must examine claims before they issue, the USPTO could not simply reissue Hornback's claims with the proposed changes via Certificate of Correction.[9/] Id. The

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[9/] Following the April 3, 2008 USPTO decision, Defense counsel contacted Plaintiff. When (continued...)

USPTO reiterated that in this context, claims can only be substantively amended under the reissue statute, 35 U.S.C. § 251. Id.

On Jan. 29, 2008, the USPTO issued a Certificate of Correction incorporating changes to the specification agreed to by the parties. Exhibit K. This certificate did not include any changes to the claims.

Dissatisfied with the form of this correction, Hornback complains that the USPTO should have complied with his request to issue an entirely new patent. Pet. at 1, 3, 6. He maintains that because the errors were too numerous, correction via a Certificate of Correction was "inappropriate in form." Id. at 3.

Hornback further argues that the USPTO must issue a new patent containing what he deems "the allowed patent claims." Id. at 4. Specifically, although the claims of his patent correspond to the version he submitted in his first amendment, dated May 1, 1987, Hornback maintains that the USPTO must immediately reissue his patent having the language of the claims as found in his second amendment, the May 6 version of the claims. Id. at 4, 6. In his current petition, he argues that this alleged error is no accident, that the PTO "willfully conspire[d]" with the Department of Defense and that the Government acted with "malice." Id. at 6. Hornback is wrong on all counts.

III

ARGUMENT

A. STANDARD FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED AND LACK OF SUBJECT MATTER JURISDICTION

In deciding a motion to dismiss for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6), the Court must accept as true all well-pleaded allegations of fact set forth in the complaint in a light most favorable to the plaintiff. Warren v. Fox Family Worldwide, Inc., 328 F.3d 1136, 1139 (9th Cir. 2003). In order to survive a

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[9](...continued)
asked by Defense Counsel whether Plaintiff was willing to drop the instant lawsuit in favor of proceeding with a reissue application as required by statute, Plaintiff declined and elected to continue with this mandamus action. Declaration of Steve B. Chu at ¶ 1.

motion to dismiss for failure to state a claim, plaintiffs must allege "enough facts to state a claim to relief that is plausible on its face." Bell Atl. Corp. v. Twombly, 550 U.S. ----, ----, 127 S.Ct. 1955, 1974, 167 L.Ed.2d 929 (2007); Butler v. City of Sacramento, 2007 WL 2275218, 2 (E.D. Cal. 2007). While a complaint need not plead "detailed factual allegations," the factual allegations it does include "must be enough to raise a right to relief above the speculative level." Id. at 1964-65. The Court need not, however, "assume the truth of legal conclusions merely because they are cast in the form of factual allegations." Warren, 328 F.3d at 1139. See also Sheehan v. United States, 896 F.2d 1168, 1171 (9th Cir. 1990) (in examining exceptions to the Government's waiver of sovereign immunity under the Federal Tort Claims Act ("FTCA"), the Court looks to conduct upon which the claim is based and not on plaintiff's characterization of the claim), amended by, 917 F.2d 424 (9th Cir. 1990).

By the same token, a subject matter jurisdiction challenge under Fed. R. Civ. P. 12(b)(1) may be made on the face of the pleadings or by use of extrinsic evidence. Warren, 328 F.3d at 1139.

B. HORNBACK'S MANDAMUS PETITION SHOULD BE DISMISSED FOR LACK OF SUBJECT MATTER JURISDICTION AND FAILURE TO STATE A CLAIM ON WHICH RELIEF CAN BE GRANTED

1. Hornback Has Not Shown That the Court Has Jurisdiction to Hear His Petition for Writ of Mandamus—That the Defendant Has Waived Sovereign Immunity

This Court lacks jurisdiction to issue the relief Hornback seeks and, therefore, should dismiss the petition in accordance with Fed. R. Civ. P. 12(b)(1). The burden of establishing jurisdiction in a court lies with the party seeking to invoke the court's jurisdiction. KVOS, Inc. v. Assoc. Press, 299 U.S. 269, 278 (1936); Rio Properties, Inc. v. Rio Intern. Interlink, 284 F.3d 1007, 1019 (9th Cir. 2002) ("Although the defendant is the moving party on a motion to dismiss, the plaintiff bears the burden of establishing that jurisdiction exists."). Under the principle of sovereign immunity, the United States may only be sued where it has expressly waived its immunity by statute. Block v. North Dakota, 461 U.S. 273, 287 (1983). Whether the United States has waived its immunity is a question of this Court's subject matter jurisdiction. United States v. Sherwood, 312 U.S. 584, 586 (1941) ("[T]he terms of [the United States'] consent to be sued in any court define that court's jurisdiction to entertain the suit."); McCarthy v. United States, 850 F.2d 558, 560 (9th Cir. 1988).

First, Hornback's Mandamus request is improper because it seeks an order instructing the Director how to exercise his discretion. Pet. at 1. Thus, his request for Mandamus relief is improper. Mandamus may not be used to instruct an official how to exercise his or her discretion. Wilmot v. Doyle, 403 F.2d 811, 816 (9th Cir. 1968). Because the applicable statute vests the USPTO Director with the discretion to determine the form of the correction— whether to issue a Certificate of Correction or an entirely new patent— Mandamus relief is not appropriate. 35 U.S.C. § 254 (stating, "The Director may issue a corrected patent . . . in lieu of . . . a certificate of correction.").

Second, Hornback's pleading invokes the Mandamus Statute, 28 U.S.C. § 1361. But he has failed to allege any relevant jurisdictional basis for his petition. Pet. at 1, 7. A suit in Mandamus to compel Government agents to perform an action is a suit against the United States, and it is barred unless there has been a waiver of sovereign immunity. See Hou Hawaiians v. Cayetano, 183 F.3d 945, 947 (9th Cir. 1999); and see White v. Admn'r of Gen. Serv. Admin. of U.S., 343 F.2d 444 (9th Cir. 1965). The Mandamus statute itself does not waive the sovereign immunity of the government, nor does the cited sections of the Patent Act, 35 U.S.C. § 254, waive the sovereign immunity of the government. The only other cause of action that the plaintiff may assert is under the Administrative Procedures Act. As the Court in Hou Hawaiians explained: "The Administrative Procedure Act, 5 U.S.C. § 702, waives immunity only for claims alleging that an official's actions 'were unconstitutional or beyond statutory authority.'" Swan v. Clinton, 100 F.3d 973, 981 (D.C. Cir.1996)." Hornback has made no such allegations. Thus, Hornback has not established any subject matter jurisdiction of the Court.

2. Hornback Is Not Entitled to Mandamus Relief Because He Has Other Avenues of Relief Available to Him at the USPTO Which He Has Not Exhausted

Hornback is not entitled to Mandamus relief. Mandamus is a "drastic" remedy "to be invoked only in extraordinary situations." Kerr v. United States District Court, 426 U.S. 394, 402, 96 S.Ct. 2119, 48 L.Ed.2d 725 (1976); Calderon v. United States District Court, 134 F.3d 981, 983 (9th Cir.1998). The key factor in deciding whether a petitioner is entitled to this extraordinary relief is whether the party seeking the writ has no other adequate means to attain the relief he or she desires. See Phoenix Newspapers, Inc. v. United States District Court, 156 F.3d 940, 951-52 (9th Cir.1998); Bauman v. United States, 557 F.2d 650, 654-55 (9th Cir.1977). Because Hornback has at least one other avenue for correcting his patent, and has made almost no effort to pursue that option, he is not entitled to mandamus relief.

The USPTO has very limited authority to act to correct errors in an issued patent; it can only take action specifically authorized by Congress. McCormick Harvesting Machine Co. v. Aultman & Co., 169 U.S. 606, 608-10 (1898). Congress has established two procedures by which a patentee can correct errors in his or her patent relevant here: i) 35 U.S.C. §§ 254 and 255, which authorize the USPTO to correct mistakes in a patent via "Certificates of Correction;" and ii) the reissue statute, 35 U.S.C. § 251.[10] Under the first, the USPTO has already done all it can to correct errors in his patent's specification via a Certificate of Correction, and simply is not authorized to substantively amend his claims without first finding them patentable. As to the second, reissue, Hornback's submissions to date fall woefully short of what is required to provide him the relief he seeks.

a. Certificates of Correction Cannot be Used to Make Substantive Changes to Patent Claims

First, 35 U.S.C. §§ 254 and 255 authorize the USPTO to correct mistakes in a patent via "Certificates of Correction." The USPTO issues Certificates of Correction typically only to correct minor errors, usually typographical or clerical in nature. Superior Fireplace Co. v. Majestic Products Co., 270 F.3d 1358, 1369-70 (Fed. Cir. 2001) ("clerical or typographical mistakes are generally understood to include simple mistakes such as obvious misspellings that are immediately apparent"); Fina Technology, Inc. v. Ewen, 265 F.3d 1325, 1328 (Fed. Cir. 2001) (certificate of correction is available to correct a "clerical error . . . [such as] correcting a misspelled word or adding a prior art reference that was submitted to and discussed by the examiner but inadvertently omitted by the applicant on PTO Form 1449 for listing references."); see also Hallmark Cards, Inc. v. Lehman, 959 F.Supp. 539, 543 (D.D.C. 1997). Certificates of Correction cannot change the scope of the claims so much that examination is required. Central Admixture Pharmacy Services, Inc. v. Advanced Cardiac Solutions, P.C. , 482 F.3d 1347, 1353 (Fed. Cir. 2007) ("A patentee who has 'made a mistake of a clerical or typographical nature, or of minor character' may apply to the PTO for a 'certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination.'") (citing 35 U.S.C. § 255) (emphasis added); Arthrocare Corp. v. Smith & Nephew, Inc., 406 F.3d 1365, 1374 (Fed. Cir. 2005) (changes to claims may only correct "a ministerial error").

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[10] In a third alternative, a patent that issued having one or more claims that are invalid over prior art may be corrected via reexamination, in accordance with 35 U.S.C. § 303(a). Reexamination is only proper, however, if a printed publication or issued patent raises a substantial new question of patentability of the patented claims over that prior art. Id. Because there is no new art at issue in this case, reexamination could not be invoked to provide Hornback the relief he seeks.

As noted, although Hornback did not file a formal request for a Certificate of Correction, in the interests of justice, the USPTO did all that it could by treating his informal, improper request for a "reissue" as a proper request under 35 U.S.C. § 254 and 37 C.F.R. § 1.322(b). Ex. G. The USPTO worked with Hornback to correct all of the typographic errors found in the specification of his patent. As a result, on January 29, 2008, the USPTO issued a Certificate of Correction incorporating the agreed changes to the specification. Ex. K.

The USPTO also treated Hornback's request to reissue his claims in revised form as a request to modify the claims via Certificate of Correction.[11/] Ex. G. at 3. Because his

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[11/] The USPTO determined that Hornback's second set of claims 3-6 had not been examined because Hornback had submitted them with identical numbering as original claims 3-6, in violation of the applicable regulations. Exhibit J at 5-6. Specifically, under the applicable rules, Hornback was required to either renumber the substitute set of claims and also cancel the first (claim 3-6 replaced with new claims 7-9), or indicate the specific changes made to the claims by underlining additions and placing deleted words in bracketing. See 37 C.F.R. § 1.121 (1987) and 37 C.F.R. § 1.126 (1987). Hornback did neither. Because Hornback's "improper" submission of substitute claims caused the alleged error, the USPTO found that the alleged error was Hornback's mistake. Exhibit J at 5-6. As a result, Hornback's request should have been filed under 35 U.S.C. § 255, "applicant's mistake."

requested changes were substantive, and required examination before they could issue, the USPTO informed Hornback that it could not amend his claims by way of Certificate of Correction. Exs. I and J. The USPTO simply does not have the authority to issue patents without, among other things, first examining the claims and ensuring that they are patentable. BlackLight Power, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002) (stating that the USPTO not only has the authority but the "obligation to assure that patents are properly examined, and valid"); Central Admixture Pharmacy Services, Inc. v. Advanced Cardiac Solutions, P.C., 482 F.3d 1347, 1353 (Fed. Cir. 2007) (changes cannot necessitate "re-examination" of the claims). Thus, the USPTO could not have granted Hornback's request to change the scope of Hornback's issued claims by way of Certificate of Correction.

b. The Reissue Statute Is the Proper Mechanism for Substantively Correcting Claims

The second avenue for correcting a patent relevant here is found in the reissue statute, 35 U.S.C. § 251. Pursuant to the reissue process, claims in an issued patent can be substantively examined and corrected if the necessary requirements are met. See Ex. H (MPEP Chapter 1400). Hornback, however, has taken none of the steps required of an applicant seeking to invoke this statute.

Reissue is permitted in those cases where the patent contains such errors as to render the patent "wholly or partly inoperative," or where the patentee claimed less than he or she was entitled to claim. 35 U.S.C. § 251. In other words, the reissue statute is typically employed where the error is substantive, such as when the claims granted are too narrow or too broad or where the description of the invention contains substantive inaccuracies. See Hewlett-Packard Co. v. Bausch & Lomb, Inc., 882 F.2d 1556, 1564 (Fed. Cir. 1989).

There are several specific requirements for filing a reissue application.[12/] Ex. H

[12/] Given that the patent process can be complicated and challenging for applicants, the USPTO has repeatedly recommended to Hornback that he hire competent counsel to represent him in these matters. Ex. J at pg. 7 (exhibit pg. 239).

(MPEP[13] Chapter 1400; particularly MPEP § 1410, "Content of Reissue Application"). For example, the patentee must provide the USPTO with a marked-up copy of the issued patent indicating the proposed changes. Id. Further, a reissue application must be accompanied by a reissue oath which complies with: 1) the requirements applicable to all oaths, found in 37 C.F.R. § 1.63; and 2) the detailed requirements to which oaths in reissue applications are held, found in 37 C.F.R. § 1.175. Id. (MPEP § 1414, "Content of Reissue Oath/Declaration"); see also, Shockley v. Arcan, Inc., 248 F.3d 1349, 1358 (Fed. Cir. 2001) (defendant challenged validity of reissue patent alleging failure to comply with 37 C.F.R. § 1.175). These are the main requirements for filing a reissue application. Substantively, the reissue claims must be directed to the "same invention" disclosed in the original patent. In re Amos, 953 F.2d 613, 618 (Fed. Cir. 1991). Reissue claims may not "recapture" subject matter surrendered during prosecution of the original application. In re Clement, 131 F.3d 1464 (Fed. Cir. 1997). More than two years after the grant of the patent, the patentee may not seek reissue claims that are broader than those originally patented. In re Graff, 111 F.3d 874, 877 (Fed. Cir. 1997).

Hornback has not submitted anything resembling a proper request for a reissue of his patent under 35 U.S.C. § 251. As a preliminary matter, has not submitted a marked-up copy of his patent, nor has he filed a reissue oath—all he has done to date is submit letters asking the USPTO to issue a new patent with new claims. Exs. C, E, and F. Having failed to address any of the formal requirements of a reissue application, as detailed MPEP Chapter 1400, the USPTO could not treat his brief letters as "reissue applications." The USPTO has already done all that it reasonably could by treating his letters as requests for Certificates of Correction under 35 U.S.C. §§ 254 and 255.

But even if Hornback had filed a reissue application, that would not be the end of his journey through the USPTO. Assuming one takes the required steps for filing a "reissue application," in the manner required, only then could a patent examiner substantively review the revised claims to determine their patentability and decide whether the application should reissue as a patent. 37 CFR § 1.176; Ex. H (MPEP § 1445, "Reissue Application Examined in Same Manner as Original Application"). If dissatisfied with the examiner's decision to reject a reissue application, the reissue applicant may seek review of that decision by the Board of Patent Appeals and Interferences ("Board"). Ex. H (MPEP 1454, "Appeal Brief"). And subsequent judicial review can be had pursuant to 35 U.S.C. § 141. Of course, having failed to file anything which the USPTO could treat as a proper reissue application, Hornback has not yet received an action from an examiner rejecting his reissue application, much less reached the stage where he could appeal a decision of an examiner to the Board or then to the courts. Thus, Hornback has not exhausted his avenues for review of agency conduct.

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[13] Since the 1940s, the USPTO has published the Manual of Patent Examining Procedure (MPEP) as a reference manual for patent examiners, applicants and attorneys on the practices and procedures relating to the patent examination process. See Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1439 (Fed. Cir. 1984). While the MPEP does not have the force of law, courts have repeatedly recognized the MPEP as the USPTO's official interpretation of statutes and regulations. Id.

Borrowing from the language used in claims brought under the Administrative Procedures Act ("APA"), Hornback's requests of this Court are not ripe because he has failed to exhaust his administrative remedies. It is a long-settled principle of administrative law that Federal Courts may decline to undertake judicial review of administrative action until all administrative remedies have been exhausted. Myers v. Bethlehem Shipbuilding Corp., 303 U.S. 41, 50-51 (1938). All administrative remedies are not exhausted when a plaintiff has an independent path within the agency to seek the desired relief available at the time the suit was brought. See Craycroft v. Ferrall, 408 F.2d 587, 592-94 (9th Cir. 1969); Ogden v. Zuckert, 298 F.2d 312, 314-17 (D.C. Cir. 1961). An issue is not ripe for review by a district court under Section 704 of the APA until the agency has issued a final decision. Nippon Miniature Bearing Corp. v. Weise, 230 F.3d 1131, 1137 (9th Cir. 2000). In other words, a determination made by a federal agency is ripe for judicial review only if: I) the issues are fit for judicial decision and, ii) withholding judicial decision would work undue hardship on the parties. Abbott Laboratories v. Gardner, 387 U.S. 136, 148-49 (1967); see also Earth Island Institute v. Ruthenbeck, 490 F.3d 687, 695 (9th Cir. 2007). "The ripeness doctrine is intended to prevent the courts, through avoidance of premature adjudication, from entangling themselves in abstract disagreements over administrative policies, and also to protect the agencies from judicial interference until an administrative decision has been formalized and its effects felt in a concrete way by the challenging parties." Principal Life Ins. Co. v. Robinson, 394 F.3d 665, 670 (9th Cir. 2004) (citations and quotations omitted).

Hornback cannot satisfy either Abbott criteria. First, having failed to present the USPTO with a proper request for relief, Hornback has not received a final agency decision, or any agency action regarding alleged error in his patent. With respect to the substantive changes to his claims, he has made no effort to follow established USPTO procedures. Second, by choosing to bring these cases in court, rather than seek relief from the USPTO, the only hardship he would suffer is his own doing. Even if this Court dismisses his case, Hornback could still file a proper application with the agency for the relief and could still obtain judicial review of any resulting adverse decision through statutorily prescribed avenues, including via appeal to the United States Court of Appeals for the Federal Circuit, as provided in 35 U.S.C. § 141.

c. The USPTO Has Discretion to Decide Whether to Issue a Corrected Patent

Having failed to exhaust his administrative remedies to correct alleged substantive errors in his claims, Hornback can hardly argue that his request for an entirely new patent should be heard. Until he files a proper reissue application, and the USPTO issues a final decision, that request would be premature. For example, if his reissue request is granted, the reissued patent would incorporate all of the changes made in the Certificate of Correction that issued on January 29, 2008. Ex. H (MPEP § 1411.01, "Certificate of Correction or Disclaimer in Original Patent").

As noted, on January 29, 2008, the USPTO did issue a Certificate of Correction incorporating the changes to the specification to which the parties agreed. Via 35 U.S.C. § 254, Congress vested the USPTO with the discretion to do just that; to determine the form of the correction. The bulk of the statute authorizes the Director to correct patents using a Certificate of Correction, and in a final sentence, authorizes the issuance of a corrected patent stating, "The Director may issue a corrected patent . . . in lieu of . . . a certificate of correction." In Southwest Software, Inc. v. Harlequin Inc., 226 F.3d 1280, 1294 (Fed. Cir. 2000), the Federal Circuit discussed the legislative history of the earlier version of this same statute, noting:

> Its purpose was "to save time and money and also promote efficiency in the operation of the Patent Office" because, when errors are detected that "are clearly clerical errors ... [the Patent Office will] append a certificate of correction to the patent to show that the error was a typographical error, and the certificate explains this, and the certificate obviates the necessity of reprinting the entire patent." 65 Cong. Rec. 6,842-43 (1924) (statement of Rep. Lanham). The statute "saves expense. It saves the reprinting of patents and allows the offering of these amended patents, with these certificates in them, in evidence rather than requiring a reprint of the entire patent." Id. at 6,843.

Id. at 1294 (emphasis added). By rule, the USPTO explained that it would only issue a new patent, "If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form." 37 C.F.R. § 1.322(b). Finding that the agreed to changes were not "so numerous" to necessitate the issuance of an entirely new patent in this case, the USPTO properly determined that correction via a Certificate of Correction was appropriate. It is also noteworthy that for purposes of litigation, issuance of the Certificate of Correction has the same effect as issuance of a corrected patent; the changes made are both treated as though "part of the original patent." 35 U.S.C. § 254; Southwest Software, Inc. v. Harlequin Inc., 226 F.3d 1280, 1295 (Fed. Cir. 2000). Thus, given the relatively few changes made to the patent, the USPTO's decision not to issue a new patent to Hornback was well within its discretion.

Under 35 U.S.C. § 255, Hornback is not entitled to a new patent. As noted, any alleged errors found in his claims are attributable to Hornback. Hornback's later filed, second set of substitute claims 3-6 were not examined because Hornback submitted them improperly; the numbering Hornback used to identify his second set of claims 3-6 was identical to those of the previously filed set of claims 3-6 (which were allowed without amendment). Exhibit J at 5-6. In doing so, he violated regulations for submitting substitute and/or amended claims. Specifically, under the applicable rules, Hornback was required to either renumber the claims while cancelling the first (cancelling claims 3-6 and replacing them with new claims 7-10), or to indicate the specific changes made to the first set by underlining any additions and placing brackets around deleted words. See 37 C.F.R. § 1.121 (1987) and 37 C.F.R. § 1.126 (1987). Hornback did neither. Because Hornback's "improper" submission of a second, substitute version of claims 3-6 caused the alleged error, the USPTO correctly found that the alleged error was Hornback's mistake. Exhibit J at 5-6. 35 U.S.C. § 254, which gives the USPTO the discretion to issue a corrected patent, can only be invoked to correct mistakes "incurred through the fault of the Patent and Trademark Office." Because Hornback caused the alleged error, Hornback's request would fall under 35 U.S.C. § 255, "applicant's mistake." But that statute makes no provision for issuing a new, corrected patent—it only authorizes the USPTO to issue a certificate of correction.

Thus, unless Hornback successfully applies for and is granted a reissue of his patent in accordance with 35 U.S.C. § 251, he will not be entitled to a new patent because: 1) the errors in his specification are not so numerous as to justify issuing a new patent, and 2) as to the changes to his claims to correct errors he caused, 35 U.S.C. § 255 does not grant the USPTO to issue a corrected patent.

IV

CONCLUSION

Hornback's petition should be dismissed because he is not entitled to mandamus relief because he has not pursued all other options of relief available to him before the USPTO. Moreover, Hornback has not established that the Court has jurisdiction to consider his petition.

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